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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/079,678	05/15/1998	VERNON L. ALVAREZ	1101-220	8606

20583 7590 07/19/2002

PENNIE AND EDMONDS  
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NEW YORK, NY 100362711

EXAMINER

TELLER, ROY R

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 07/19/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/079,678

Applicant(s)

ALVAREZ ET AL.

Examiner

Roy Teller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 75 and 109-154 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 75 and 109-154 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

The finality of the prior office action is removed. An amendment filed 6/14/02 (paper #22) has cancelled claims 31-39 and 98-108. New claims 109-154 have been added and all non canceled claims are rejoined but subject to the below requirement for restriction.

#### ***Election/Restrictions***

The peptide sequences recited in the claims are distinct and different peptides on the basis of physical, chemical, and biological properties. For example, table 23, page 110, shows several peptides with differences in pI of almost 2 pI units. Other tables in the application also appear to show that the peptides defined by sequence have different chemical and physical properties. Thus, each of the recited peptide sequences in the claim are distinct and/or independent as to physical, chemical, and biological properties and functions.

The receptor sequences recited in the claims are also distinct and different proteins on the basis of physical, chemical, and biological properties even where the application would place all as gastrointestinal tract receptors, they are all of different structure and function. For example, where HPT1 (SEQ ID NO:178) is a receptor (as recited in the claim), D2H (SEQ ID NO: 179) would appear to be an enzyme sucrase isomaltase (specification, page 11, Figure 3A-3B). The other two recited sequences are not receptors but transporters (specification, page 11). Thus, each

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of the recited receptor sequences in the claim are distinct and/or independent as to physical, chemical, and biological properties and functions.

The search of the patent and technical literature for one of the receptors and its binding partner would not have resulted in a complete search for any one of the receptor/binding peptide combination.

In view of the foregoing, restriction to one of the following inventions is required under 35 U.S.C. 121 to elect one receptor and one binding partner polypeptide by sequence identification number.

1) One patentably distinct and independent receptor from among SEQ ID NO: 178, 176, 179, and 181, class 530, subclass 350.

2) One distinct binding partner peptide selected from sequences of SEQ ID NO: 1-55 and SEQ ID NO: 253 to 265, class 530, subclass 300.

Because these inventions are distinct for the reasons given above and since they have acquired a separate status in the art as shown by their different classification and/or divergent subject matter, and/or are separately and independently searched, restriction for examination purposes as indicated is proper.

Applicant is free to elect one of item 1 and one of item 2 above to which the claims shall be restricted.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143) and a list of claims readable thereon. All prior office actions are vacated and patentability of the elected invention will be reassessed based on applicant's election. Applicant may also present appropriate amended claims.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy Teller whose telephone number is (703)305-4243. The examiner can normally be reached on Monday-Friday from 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (703) 308-2923. The fax phone number for the organization where this application or proceeding is assigned is (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

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